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Docket No.: 1349.1337

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Pil-Ho YU

Serial No. 10/725,586

Group Art Unit: 2624

Confirmation No. 3450

Filed: December 3, 2003

Examiner: John W. LEE

For: APPARATUS, METHOD, AND MEDIUM INCLUDING COMPUTER READABLE CODE
FOR MEASURING NOISE OF AN IMAGE SIGNAL

**REQUEST FOR NEW OFFICE ACTION AND
RESTARTING OF RESPONSE PERIOD**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Advisory Action issued March 26, 2008, and the Office Action issued January 10, 2008.

IMPROPER OFFICE ACTION AND ADVISORY ACTION

As noted in applicants response filed March 10, 2008, the Office Action issued January 10, 2008 was improper and failed to recite rejections of the claims. Similarly, the Advisory Action issued March 26, 2008, wherein the Examiner has now recited the rejection to the claims, is equally improper because the improperness of the original Office Action cannot be cured through an Advisory Action. A new Office Action is required.

Accordingly, a new Office Action is respectfully requested, with a re-setting of the response due date.

FAILURE TO ADDRESS APPLICANT TRAVERSALS

In addition, as noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

The rejection rationale included in the Advisory Action has not addressed each of applicants remarks included in the response filed March 10, 2008.

Any new Office Action is requested to include a complete traversal of both applicant's arguments and applicant's interpretation of the underlying references.

If the Examiner disagrees with applicant's interpretation of the references or the teaching of the same applicants respectfully request the Examiner particularly identify each error in the same.

RELIANCE ON KSR AND REQUIRED EVIDENCE IN RECORD

Briefly, the Advisory Action appears to include one encompassing argument that applicants arguments have been traversed because KSR supports the examiner's position. The Advisory Action states that a teaching/suggestion/motivation is no longer required and that any rationale supporting the rejection does not need to be supported by the record.

However, As stated by the Supreme Court:

"Often it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of the demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit."

The Supreme Court further reaffirmed In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006), which stated: "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Thus, at least some recited rationale and supporting arguments are required beyond a lone statement or conclusion. Evidence supporting the rejection rationale must still be recited in the record.

Further, in regards to KSR, the Advisory Action further relies upon KSR and MPEP 2143 as supporting the use of a "simple substitution" rationale for combining features from one reference into another.

Any rejection rationale, whether motivation/suggestion/teaching/reason or another rationale, must still be supported by the record through supporting remarks by the Examiner. The Advisory Action merely states that a simple substitution of one known element for another to

obtain predictable results or is using known technique to improve similar devices in the same way is an available rejection rationale.

However, of the multiple rejection rationales available, a prima facie obviousness case still requires that the underlying evidence or arguments relied upon by the Examiner be expressly stated in the rejection. For example, if the Examiner concludes that a feature from a secondary reference would be a mere substitution into a primary reference with predictable results, then the Office Action should expressly state what those predictable results are.

The Supreme Court also states that such obvious to try or design choice rationales could be based upon an analysis that there were limited ways to change the original device and one skilled in the art would have most likely implemented such a modification due to such limited ways.

Thus, a statement that a feature from a secondary reference would have been obvious due to it being a substitution with predictable results is insufficient to meet a prima facie obviousness case without such supporting rationales.

IMPROPER REJECTION RATIONAL OF CLAIMS 3-5 AND 8-10

The recited rejection rationale for claims 3-5 and 8-10 are also improper. This rejection rationale merely states that a secondary reference includes another feature.

However, this rejection rational is improper for lacking any recited obviousness rationale for further modifying the originally modified primary reference. The fact that the primary reference has been modified to include features from a secondary reference does not mean that each and every feature of that secondary reference is automatically also included in that combination. Each modification must meet a prima facie obviousness case.

RESTRICTION/ELECTION REQUIREMENT

Lastly, the Advisory Action indicates that applicant's argument of the original restriction requirement was without traverse since applicant only argued that the restriction was improper, and did not address the Examiner's selection of species, for example.

However, here, it is noted that any restriction/election requirement must first meet the requirements for restriction, e.g., distinct or independent inventions and the required burden on the Examiner to search such distinct or independent inventions. The same burden requirement is required in an election of species. Thus, if the original grounds for restriction/election are improper then the complete restriction/election requirement is improper. Applicant's traversal of